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EXAMINER
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ART UNIT	PAPER NUMBER
2173	

NOTIFICATION DATE	DELIVERY MODE
04/02/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	10/606,129	JACOBS ET AL.
	Examiner	Art Unit	
	ALVIN H. TAN	2173	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 January 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>53-117</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>53-117</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Remarks

1.   Claims 53-117 have been examined and rejected. This Office action is

responsive to the amendment filed on 1/4/08, which has been entered in the above

identified application.

Claim Objections

2.   The numbering of claims after claim 100 is improper. Applicant has omitted

claims 101-110 and instead, has jumped from claim 100 to claim 111. Misnumbered

claims 111-127 have been renumbered to claims 101-117, respectively, and their

dependencies have been adjusted accordingly.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

4.   Claims 53-70, 80-117 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the written description requirement. The claims contain subject

matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention. Nowhere in Applicant's specification

discloses that the identification is performed <u>without requiring the use of a special</u>

<u>identification tool</u> as has been amended to claims 53, 62, 80, and 96. Applicant's

specification only discloses that the user "may identify the portion within the document

by highlighting, clicking on, speaking, or touching the portion" *[paragraph 15 of the*

specification]. There is no mention of restrictions on what is used to highlight, click on,

speak, or touch the identified portion. For purposes of a prior art rejection and based on

the closest teaching in Applicant's specification, any manner may be used for

highlighting, clicking on, speaking, or touching the identified portion of the document.

5.   Claims 53-117 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention. Nowhere in Applicant's specification discloses <u>how to automatically transfer</u>

<u>the document into a folder associated with the identified portion when the user clicks on</u>

<u>the highlighted portion</u> as has been amended to claims 53, 62, 71, 80, and 96.

Applicant's specification does disclose highlighting a word within an e-mail document

and clicking on the word to transfer the e-mail to a folder associated with the highlighted

word *[paragraphs 15 and 18 of the specification]*. However, there is insufficient

information regarding how one would go about highlighting any portion on an e-mail

document and assigning a function to the highlighted portion, such that clicking on the

highlighted portion automatically carries out the transfer of the document. Such a

disclosure does not contain sufficient information regarding the subject matter of the

claims as to enable one skilled in the pertinent art to make and use the claimed

invention.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 53-55, 58, 60-64, 67, 69-73, 76, 78-82, 96, 97, 104, and 111 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Hung (Pub No. US 2002/0087584)

and Imielinski et al (U.S. Patent No. 7,055,094 B2), herein after Imielinski.

Claim 53, 54, 55, 58, 60, 61, 97 (Method)

Claim 62, 63, 64, 67, 69, 70, 104 (Computer Readable Medium)

Claim 71, 72, 73, 76, 78, 79, 111 (Apparatus)

Claim 80, 81, 82 (Apparatus)

Claim 96 (Processor)

7-1.   Regarding claims 53, 62, 71, 80, and 96, Hung teaches the claim comprising

presenting a document on a user interface of an apparatus, by disclosing a method and

system for organizing messages that arrive at a communication terminal or other machine *[paragraph 5, lines 1-4]*. The machine may be programmed to present a received-message to a user and to allow the user to select one or more values from the message, to be used as the message-filter expression *[paragraph 42, lines 1-4]*.

Hung teaches receiving from a user of the apparatus an identification of a portion of the document while presenting the document and automatically transferring the document into a folder associated with the identified portion, by disclosing that upon the receipt of a message, the communication terminal may present a received-message to a user and may prompt the user to select an expression from the received-message, to be used to identify a new folder, such as an expression from the body of the message. A new folder may be created to store messages that match the expression selected by the user and may store the message and other matching messages in the folder *[paragraph 6]*.

As per claims 80 and 96, Hung teaches the claim comprising a processor, memory, output device, and input device, by disclosing *[paragraph 19, figure 2]*.

Hung further teaches that any of a variety of methods may be used to select a word from the e-mail *[paragraph 43]*. Although Hung teaches receiving an identification of a portion of the document and transferring the document into a folder associated with the identified portion when the user clicks on an "OK" softkey or any other suitable selection of the word by recording the highlighted word to memory *[paragraph 43]*, the limitation of receiving an un-prompted identification and automatically transferring the document by clicking on the highlighted portion is not expressly taught. Such a method

of selecting highlighted text by clicking on it without using prompts is taught by Imielinski. Imielinski teaches identifying portions of a document by highlighting and selecting the identified portions by clicking on it *[column 8, lines 48-62]*. Clicking on the identified portion to authorize selection allows users to more efficiently select various portions of a document since the user need not navigate to a separate location within the interface for selection of a command prompt to choose the identified portion. The fact that the user is prompted for confirmation of a selected portion of the document in Hung merely provides additional help to the user when selecting the portion. In this case, the prompt given in Hung allows the user to confirm that the selection made was in fact correct. Thus, the prompt may be eliminated and the selection of text by clicking on an identified portion may be performed without any adverse effect to the essential function of the e-mail organizing system of Hung. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow un-prompted identification of a portion of the document and clicking on the identified portion to select the portion, as taught by Imielinski, to initiate automatic transfer of the document into a folder associated with the identified portion. This would make the program more efficient by eliminating the extra step of prompting the user for confirmation when selecting text for organizing e-mail messages.

7-2.   Regarding claims 54, 63, 72, and 81, Hung and Imielinski teach the claim wherein said automatically transferring further comprises automatically creating a new folder associated with the un-prompted identified portion if a pre-established folder

associated with the identified portion does not exist, and transferring the document to the new folder, by disclosing that if the message does not satisfy the message-filter expression of any existing folder, a new folder for the message may be created by selecting a portion of the document *[Hung, paragraph 74]*.

7-3.   Regarding claims 55, 64, 73, and 82, Hung and Imielinski teach the claim wherein said automatically transferring further comprises one of transferring the document to a pre-established folder associated with the un-prompted identified portion and transferring the document to a new folder, by disclosing that the message may be stored in a pre-established folder or a newly created folder *[Hung, paragraph 74]*.

Hung and Lewis teach wherein transferring the document to the new folder further comprises automatically creating the new folder in association with the un-prompted identified portion if the pre-established folder does not exist, by disclosing that if the message does not satisfy the message-filter expression of any existing folder, a new folder for the message may be created by selecting a portion of the document *[Hung, paragraph 74]*.

7-4.   Regarding claims 58, 67, and 76, Hung and Imielinski teach the claim wherein said receiving comprises receiving a selection of at least one of a word and a symbol, by disclosing that the user can select a value from a text message *[Hung, paragraph 42]*.

7-5.   Regarding claims 60, 69, and 78, Hung and Imielinski further teach the claim of

the method wherein said receiving comprises receiving a spoken representation of the

portion, by disclosing that input means includes a microphone *[Hung, paragraph 19,*

lines 11-15].

7-6.   Regarding claims 61, 70, and 79, Hung and Imielinski further teach the claim of

the method wherein said receiving comprises receiving a touch associated with the

portion, by disclosing that input means includes a touch sensitive display *[Hung,*

paragraph 19, lines 11-15].

7-7.   Regarding claims 97, 104, and 111, Hung and Imielinski further teach the claim

of the method wherein the folder includes a pre-established folder, by disclosing that if

the message satisfies an existing message-filter expression, the message may be

stored in that folder *[Hung, paragraph 74]*.

8.   Claims 56, 57, 59, 65, 66, 68, 74, 75, 77, 83-89 are rejected under 35 U.S.C.

103(a) as being unpatentable over Hung (Pub No. US 2002/0087584), Imielinski et al

(U.S. Patent No. 7,055,094 B2), and Clark et al (US Patent No 6,725,228).

Claim 56, 57, 59 (Method)

Claim 65, 66, 68 (Computer Readable Medium)

Claim 74, 75, 77 (Apparatus)

Claims 83-89 (Apparatus)

8-1.   Regarding claims 56, 57, 65, 66, 74, 75, 83, and 84, Hung and Imielinski teach

the invention in accordance with claims 53, 62, 71, and 80. Hung and Imielinski further

teach the claim further comprising receiving an un-prompted identification of at least

one other portion of the document while presenting the document, by disclosing that

more than one portion of the document may be selected *[Hung, paragraph 73]*.

Hung and Imielinski teach that if the message does not satisfy the message-filter

expression of any existing folder, a new folder for the message may be created by

selecting a portion of the document *[Hung, paragraph 74]*.

Hung and Imielinski do not expressly teach automatically transferring the

document into at least one other folder associated with each identified other portion of

the document. Clark teaches a similar invention that organizes messages into multiple

folders based on the contents and attributes of the message *[column 4, lines 26-39]*.

Clark's invention improves upon prior art by teaching that in the prior art, filtering rules

cannot organize a message into multiple folders without creating multiple copies of the

message *[column 2, lines 28-32]*. Thus, Clark teaches that the ability to organize a

message into multiple folders using filtering rules is well known.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to include, in the system for organizing messages of Hung and

Imielinski, transferring messages into multiple folders, as taught by Clark. This would

give the user more flexibility when organizing messages since the user would not be

restricted to a single folder. Further, in accordance with Hung *[paragraph 74]*, if a pre-

established folder associated with the respective identified other portion does not exist,

a new folder will be created and the document would be transferred to it.

8-2.   Regarding claims 59, 68, 77, and 86, Hung and Imielinski further teach that

words may be presented to the user, in which case, the user selects the word *[Hung,*

paragraph 43]. The communication terminal may be a notebook computer *[Hung,*

paragraph 16].

        Hung and Imielinski do not expressly teach the claim wherein said receiving

comprises receiving a click on the portion. Clark teaches that a message client provides

a user interface on a laptop computer *[Clark, column 12, lines 7-10]* and receives user

input from the interface using an input device such as a mouse *[Clark, column 9, lines*

30-35].

        It would have been obvious to one of ordinary skill in the art at the time the

invention was made to include, in the system of organizing messages of Hung and

Imielinski, the use of a mouse as an input device, as taught by Clark. The use of a

mouse as an input device provides a more flexible input device for inputting commands.

This would allow a user to select the word by clicking on it.

8-3.   Regarding claims 85, Hung, Imielinski, and Clark teach the claim wherein said

receiving comprises receiving a selection of at least one of a word and a symbol, by

disclosing that the user can select a value from a text message *[Hung, paragraph 42]*.

8-4.   Regarding claims 87, Hung, Imielinski, and Clark further teach the claim of the
method wherein said receiving comprises receiving a spoken representation of the
portion, by disclosing that input means includes a microphone *[Hung, paragraph 19,
lines 11-15]*.

8-5.   Regarding claims 88, Hung, Imielinski, and Clark further teach the claim of the
method wherein said receiving comprises receiving a touch associated with the portion,
by disclosing that input means includes a touch sensitive display *[Hung, paragraph 19,
lines 11-15]*.

8-6.   Regarding claims 89, Hung, Imielinski, and Clark further teach the claim of the
method wherein the folder includes a pre-established folder, by disclosing that if the
message satisfies an existing message-filter expression, the message may be stored in
that folder *[Hung, paragraph 74]*.

9.   Claims 98, 99, 105, 106, 112, and 113 are rejected under 35 U.S.C. 103(a) as
being unpatentable over Hung (Pub No. US 2002/0087584). Imielinski et al (U.S. Patent
No. 7,055,094 B2), and Internet Explorer 5, as taught by Freeze ("Sams' Teach Yourself
Microsoft Internet Explorer 5 in 24 Hours", 1999).

Claims 98, 99 (Method)

Claims 105, 106 (Computer Readable Medium)

Claims 112, 113 (Apparatus)

9-1.   Regarding claims 98, 105, and 112, Hung and Imielinski teach the invention in accordance with claims 53, 62, and 71, respectively. Hung and Imielinski do not expressly teach further indicating that the document is being transferred into the folder. Freeze teaches that Internet Explorer shows a download status screen when a document is being transferred to a computer *[page 392]*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung and Imielinski, the use of a status screen to show the transfer of a document to a folder, as taught by Freeze. This would alert the user that a document is being transferred.

9-2.   Regarding claims 99, 106, and 113, Hung and Imielinski teach the invention in accordance with claims 53, 62, and 71, respectively. Hung and Imielinski do not expressly teach the claim of the method further indicating that the document has been transferred to the second folder. Freeze teaches that Internet Explorer displays a message indicating that the transfer of a document to a folder has been completed *[page 393]*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung and Imielinski, the use of message window to indicate that the transfer of a document to a folder has been completed, as taught by Freeze. This would alert the user that a document has been transferred.

10.   Claims 100-103, 107-110, 114-117, and 90-95 are rejected under 35 U.S.C.

103(a) as being unpatentable over Hung (Pub No. US 2002/0087584), Imielinski et al

(U.S. Patent No. 7,055,094 B2), Clark et al (US Patent No 6,725,228), and Internet

Explorer 5, as taught by Freeze ("Sams' Teach Yourself Microsoft Internet Explorer 5 in

24 Hours", 1999).

Claim 100-103 (Method)

Claim 107-110 (Computer Readable Medium)

Claim 114-117 (Apparatus)

10-1.   Regarding claims 100, 107, and 114, Hung and Imielinski teach the invention in

accordance with claims 53, 62, and 71, respectively. Hung and Imielinski do not

expressly teach transferring the document into a second folder associated with a

second identified portion. Clark teaches a similar invention that organizes messages

into multiple folders based on the contents and attributes of the message *[column 4,*

lines 26-39]. Clark's invention improves upon prior art by teaching that in the prior art,

filtering rules cannot organize a message into multiple folders without creating multiple

copies of the message *[column 2, lines 28-32]*. Thus, Clark teaches that the ability to

organize a message into multiple folders using filtering rules is well known.

        It would have been obvious to one of ordinary skill in the art at the time the

invention was made to include, in the system for organizing messages of Hung and

Lewis, transferring messages into multiple folders, as taught by Clark. This would give

the user more flexibility when organizing messages since the user would not be restricted to a single folder.

Hung, Imielinski, and Clark do not expressly teach further indicating that the document is being transferred into the second folder. Freeze teaches that Internet Explorer shows a download status screen when a document is being transferred to a computer *[page 392]*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung, Imielinski, and Clark, the use of a status screen to show the transfer of a document to a folder, as taught by Freeze. This would alert the user that a document is being transferred.

10-2.   Regarding claims 101, 108, and 115, Hung and Imielinski teach the invention in accordance with claims 53, 62, and 71, respectively. Hung and Imielinski do not expressly teach transferring the document into a second folder associated with a second identified portion. Clark teaches a similar invention that organizes messages into multiple folders based on the contents and attributes of the message *[column 4, lines 26-39]*. Clark's invention improves upon prior art by teaching that in the prior art, filtering rules cannot organize a message into multiple folders without creating multiple copies of the message *[column 2, lines 28-32]*. Thus, Clark teaches that the ability to organize a message into multiple folders using filtering rules is well known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung and

Imielinski, transferring messages into multiple folders, as taught by Clark. This would

give the user more flexibility when organizing messages since the user would not be

restricted to a single folder.

Hung, Imielinski, and Clark do not expressly teach the claim of the method

further indicating that the document has been transferred to the second folder. Freeze

teaches that Internet Explorer displays a message indicating that the transfer of a

document to a folder has been completed *[page 393]*. It would have been obvious to

one of ordinary skill in the art at the time the invention was made to include, in the

system for organizing messages of Hung, Imielinski, and Clark, the use of message

window to indicate that the transfer of a document to a folder has been completed, as

taught by Freeze. This would alert the user that a document has been transferred.

10-3. Regarding claims 102, 103, 109, 110, 116 and 117, Hung, Imielinski, Clark, and

Freeze teach the invention in accordance with claims 101, 108, and 115. Hung further

teaches that the message may be stored in a pre-established folder or a newly created

folder *[Hung, paragraph 74]*.

Claims 90-95

10-4. Regarding claim 90, Hung, Imielinski, and Clark teach the invention in

accordance with claim 83. Hung, Imielinski, and Clark do not expressly teach further

indicating that the document is being transferred into the folder. Freeze teaches that

Internet Explorer shows a download status screen when a document is being

transferred to a computer *[page 392]*.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to include, in the system for organizing messages of Hung,

Imielinski, and Clark, the use of a status screen to show the transfer of a document to a

folder, as taught by Freeze. This would alert the user that a document is being

transferred.

10-5. Regarding claim 91, Hung, Imielinski, and Clark teach the invention in

accordance with claim 83. Hung, Imielinski, and Clark do not expressly teach the claim

of the method further indicating that the document has been transferred to the second

folder. Freeze teaches that Internet Explorer displays a message indicating that the

transfer of a document to a folder has been completed *[page 393]*.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to include, in the system for organizing messages of Hung,

Imielinski, and Clark, the use of message window to indicate that the transfer of a

document to a folder has been completed, as taught by Freeze. This would alert the

user that a document has been transferred.

10-6. Regarding claim 92, Hung, Imielinski, and Clark teach the invention in

accordance with claim 83. Hung and Imielinski do not expressly teach transferring the

document into a second folder associated with a second identified portion. Clark

teaches a similar invention that organizes messages into multiple folders based on the contents and attributes of the message *[column 4, lines 26-39]*. Clark's invention improves upon prior art by teaching that in the prior art, filtering rules cannot organize a message into multiple folders without creating multiple copies of the message *[column 2, lines 28-32]*. Thus, Clark teaches that the ability to organize a message into multiple folders using filtering rules is well known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung and Imielinski, transferring messages into multiple folders, as taught by Clark. This would give the user more flexibility when organizing messages since the user would not be restricted to a single folder.

Hung, Imielinski, and Clark do not expressly teach further indicating that the document is being transferred into the second folder. Freeze teaches that Internet Explorer shows a download status screen when a document is being transferred to a computer *[page 392]*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung, Imielinski, and Clark, the use of a status screen to show the transfer of a document to a folder, as taught by Freeze. This would alert the user that a document is being transferred.

10-7. Regarding claim 93, Hung, Imielinski, and Clark teach the invention in accordance with claim 83. Hung and Imielinski do not expressly teach transferring the

document into a second folder associated with a second identified portion. Clark teaches a similar invention that organizes messages into multiple folders based on the contents and attributes of the message *[column 4, lines 26-39]*. Clark's invention improves upon prior art by teaching that in the prior art, filtering rules cannot organize a message into multiple folders without creating multiple copies of the message *[column 2, lines 28-32]*. Thus, Clark teaches that the ability to organize a message into multiple folders using filtering rules is well known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung and Imielinski, transferring messages into multiple folders, as taught by Clark. This would give the user more flexibility when organizing messages since the user would not be restricted to a single folder.

Hung, Imielinski, and Clark do not expressly teach the claim of the method further indicating that the document has been transferred to the second folder. Freeze teaches that Internet Explorer displays a message indicating that the transfer of a document to a folder has been completed *[page 393]*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include, in the system for organizing messages of Hung, Imielinski, and Clark, the use of message window to indicate that the transfer of a document to a folder has been completed, as taught by Freeze. This would alert the user that a document has been transferred.

10-8.   Regarding claims 94 and 95, Hung, Imielinski, Clark, and Freeze teach the

invention substantially as claimed. Hung further teaches that the message may be

stored in a pre-established folder or a newly created folder *[Hung, paragraph 74]*.

Response to Arguments

11.   The Examiner acknowledges the Applicant's amendments to claims 53, 62, 71,

80, and 96, the cancellation of claims 7-13, 20-26, and 33-39, and the addition of claims

97-117. Regarding claims 53, 62, 71, 80, and 96, Applicant alleges that Hung (Pub No.

US 2002/0087584) and Lewis et al (U.S. Patent No. 6,795,806 B1), as described in the

previous Office action, do not explicitly teach that a message transfer can be triggered

by highlighting a portion of the document and then clicking on the highlighted portion, as

has been amended to the claims. Examiner has therefore rejected independent claims

53, 62, 71, 80, and 96 under 35 U.S.C § 103 as being unpatentable over Hung and

Imielinski et al (U.S. Patent No. 7,055,094 B2). See section 7-1.

        Applicant states that dependent claims 54-61, 63-70, 72-79, 81-95, and 97-117

recite all the limitations of the independent claims, and thus, are allowable in view of the

remarks set forth regarding independent claims 53, 62, 71, and 80. However, as

discussed above, Hung and Imielinski are considered to teach claims 53, 62, 71, and

80, and consequently, claims 54-61, 63-70, 72-79, 81-95, and 97-117 are rejected.

Conclusion

12.   The prior art made of record on attached form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R § 111(c) to consider these references fully when responding to this action. The documents cited therein teach similar systems for transferring a document into a folder.

13.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to <u>ALVIN H. TAN</u> whose telephone number is <u>(571)272-8595</u>. The examiner can normally be reached on Mon-Fri 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on 571-272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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